

REMARKS**I. General**

Claims 1-101 were pending in the application, and all of such claims were rejected in the Office Action mailed January 7, 2005. The issues raised in the present Office Action are:

- Effectiveness of Declaration of Alan Cayton under 37 C.F.R. § 1.131;
- Claims 1-21, 28-43, 46, 48-71, 78-79, 81, 83, and 85-101 are rejected under 35 U.S.C. § 102(a) as being unpatentable over various web pages retrieved from the Internet archive “Way Back Machine” for www.accuhire.com (hereinafter “Accuhire”);
- Claims 22-27, 44, 45, 47, and 72-77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Accuhire* in view of U.S. Patent Number 5,978,768 issued to McGovern et al. (hereinafter “McGovern”); and
- Claims 80, 82, and 84 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Accuhire*.

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Declaration Under 37 C.F.R. § 1.131

The current Office Action asserts, on page 15 thereof, that the Declaration of Cayton filed December 9, 2004 under 35 C.F.R. § 1.131 is ineffective for the date of June 12, 2000. First, the Examiner contends that the evidence submitted is insufficient to establish a conception of the invention prior to June 12, 2000. Further, the Examiner asserts that the Declaration fails to adequately account for activity during the period for which diligence is required. Applicant addresses each of these points below, and respectfully submits that in view of the new Declaration submitted herewith under 35 C.F.R. § 1.131, the Declaration is effective.

A. Sufficiency of Evidence of Conception of Invention

The current Office Action asserts, at page 15 thereof, that the evidence submitted with the Declaration of Cayton filed December 9, 2004 is insufficient to establish a conception of the invention prior to June 12, 2000. Applicant respectfully disagrees. As set forth in M.P.E.P. § 715.07, conception is the mental part of the inventive act, but it must be capable of proof, as by drawings. *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), which is cited by the current Office Action, established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. Applicant respectfully submits that the evidence submitted in the Declaration filed December 9, 2004, and re-submitted in the Declaration submitted herewith is sufficient to establish conception by Applicant prior to June 12, 2000, as discussed further below.

Applicant submits evidence (as Exhibit A to the Declaration) that includes FIGURES, which correspond to FIGURE 1 of the present application. The Declaration sets forth that Alan Cayton comprehended an embodiment of this invention, as described more fully in conjunction with FIGURE 1 of the present application, prior to June 12, 2000. The Examiner is respectfully reminded that evidence of actual reduction to practice is not required. Rather, Applicant's evidence (i.e., possession of FIGURE 1 of the present application) is sufficient to give rise to an inference that the invention was conceived prior to June 12, 2000, particularly considering that the inventor declares that he had conceived of the details set forth for this FIGURE in the present application prior to June 12, 2000.

Further, the FIGURES included in the evidence submitted are not a "mere vague idea" of how to solve a problem, but instead identify the elements and illustrates interaction between the elements. More specifically, the FIGURES included in the evidence show an application generator with an associated user interface coupled therewith. The FIGURES further show IVR and Browser (web-based) applications that are illustrated as generated by the application generator. The IVR and Browser applications are labeled as "SAQs", and the evidence further includes pages explaining that SAQ (Self-Administered Qualification, *see* page 1 of Exhibit A) is: "A Software Product That Provides a Powerful, Customized Operating Environment for Applicant Screening, Qualification and Scheduling" (*see* page 3

of Exhibit A). Thus, the IVR and Browser applications generated by the application generator are described as software applications for qualifying candidates. Further, the FIGURE on page 2 of Exhibit A shows a common symbol used for representing a telephone coupled to the IVR application, thus illustrating that a candidate can interact with the IVR application via a telephone. The FIGURE further shows the Browser application as coupled to the World Wide Web (WWW) communication network, and a representation of a computer (e.g., PC) coupled to the WWW network, thus illustrating that a candidate can interact with the Browser application via a computer coupled to the WWW network. Accordingly, this evidence shows that the inventor possessed more than a mere vague idea because it shows the various elements and their interactions.

Further, to dispose of a reference, Applicant need only establish prior conception of as much of the claimed invention as the reference happens to show. For instance, in *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957), the CCPA concluded:

We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [sic] happens to show. When he has done that he has disposed of the references....

In the case of a reference, it is fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all....

The rule [1.131] must be construed in accordance with the rights given to inventors by statute and this excludes a construction permitting the further use of a reference as a ground of rejection after all pertinent subject matter in it has been antedated to Dean satisfaction of the patent office.

In the present case, Applicant's evidence certainly shows at least as much detail as is provided in the *Accuhire* web pages applied in the present Office Action, which the Office Action asserts to have a date of June 12, 2000. Indeed, Applicant's evidence more clearly sets forth that an application generator generates the applications (e.g., IVR SAQs and Browser SAQs) than does the *Accuhire* web pages. The *Accuhire* web pages do not clearly establish that an application generator generates the application to interact with candidates. To the extent that any such inference can be drawn from the teaching in *Accuhire*, the evidence submitted in Applicant's Declaration clearly establishes priority with respect to so much of the claimed invention as the *Accuhire* reference teaches. That is, the evidence

provides at least as much detail concerning an application generator generating applications with which candidates can interact as does the applied *Accuhire* reference.

In view of the above, Applicant respectfully submits that the Declaration and its corresponding evidence submitted herewith is sufficient to establish conception prior to June 12, 2000.

B. Diligence

Applicant respectfully submits that the new Declaration submitted herewith under 35 C.F.R. § 1.131 provides sufficient information regarding the activity during the period for which diligence is required to establish such diligence on the part of Applicant. As the Declaration sets forth, Applicant diligently worked toward seeking patent counsel, engaging patent counsel for preparing and filing the present application, discussing the invention with patent counsel, reviewing drafts of the patent application provided by patent counsel, providing timely feedback on the drafts of the patent application to patent counsel, and timely approving the final draft of the patent application and executing the declaration for such patent application and returning such executed declaration to patent counsel for filing of the patent application, which patent counsel timely filed with the USPTO after receiving the executed declaration. Applicant respectfully submits that the above activity is sufficient to establish diligence on the part of Applicant during the period for which such diligence is required.

III. Rejection Under 35 U.S.C. § 102 over *Accuhire*

Claims 1-21, 28-43, 46, 48-71, 78-79, 81, 83, and 85-101 are rejected under 35 U.S.C. § 102(a) as being unpatentable over *Accuhire*. Applicant respectfully traverses this rejection as being improper on several grounds, as explained further below.

A. The Applied Art Is Not Proper “Prior Art”

The *Accuhire* reference contains various web pages which are not properly available as prior art. If an Internet publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), *see* M.P.E.P. § 2128. That is, the M.P.E.P. clearly establishes that for an Internet publication to be used as a prior art

reference, such Internet publication must include a publication date or retrieval. A review of the *Accuhire* web pages cited by the Examiner in this case reveals that no publication date information (or even copyright date) is present therein. Although there appears to be a date of retrieval of these web pages, that date is December 30, 2004, which is insufficient to present a bar to patentability with respect to the present claims which have a filing date of August 17, 2000. Most of the pages cited have a URL printed across the bottom of the page that includes what could be a year (although whether this portion of the URL is a date, and whether such date is accurate is unclear). To the extent that such portion of the URL is a date, all of the pages including such URL have either 2001 or 2002 as the year, and thus would fail to pre-date the filing date of the present application. Accordingly, it is respectfully asserted that the *Accuhire* web pages are not properly available as prior art with respect to the present claims, *see* M.P.E.P. § 2128.

The Examiner relies upon the date information proffered by the Internet Archive “Wayback Machine,” www.archive.org, (hereinafter “*Wayback Machine*”) in attempt to establish the publication date of the relied-upon *Accuhire* web pages. Again, because the pages themselves do not include a publication date (and the retrieval date fails to establish them as prior art), such pages are not available as prior art under M.P.E.P. § 2128.

Furthermore, even if office procedure permitted the Examiner to rely on archival dates proffered by a third party archiving organization, such as the *Wayback Machine*, (which as described above it does not, but instead requires that the pages themselves include the relied-upon dates) the accuracy of the dates proffered by the *Wayback Machine* has not been established. That is, a third party could, either intentionally or mistakenly, archive a web page as being available as of a date that it actually was not available. The web is notorious for providing incorrect information. As discussed above, the pages themselves do not include a date to enable any verification of the accuracy of the date proffered by the *Wayback Machine*, except for the date of retrieval which is December 30, 2004.

Further still, even if the dates proffered by the *Wayback Machine* are accurate (while this has not been established), the earliest date for which archival documents are available for *Accuhire* is identified as October 17, 2000 by the *Wayback Machine*, *see* results screen titled “Search Results for Jan 01, 1996 – Dec 30, 2004”. Two pages are identified in 1999,

specifically identified as having dates of Nov 27, 1999 and Nov 29, 1999, respectively. However, upon attempting to access these pages via the *Wayback Machine*, the user is informed that the requested page has not been archived. Thus, the pages cited by the current Office Action are not those corresponding to the Nov 27, 1999 and Nov 29, 1999 dates. The page identified by the *Wayback Machine* as having a date of Oct 7, 2000, is retrievable. However, such pages assigned the date of October 17, 2000 are not prior art to the present claims, which have a filing date of August 17, 2000. Thus, even taking the dates proffered by the *Wayback Machine* as being accurate, no archival pages are available that pre-date the filing date of the present application.

The Examiner also provides what he refers to as “Screen Print of Web Page Initial Upload”. However, it is unclear to Applicant how (or even if) this screen was retrieved from the *Wayback Machine* for the Accuhire website. The Examiner appears to assert that this screen illustrates that certain *Accuhire* web pages were uploaded to the *Wayback Machine* on June 12, 2000. Of course, the date of June 12, 2000 does not correspond with any of the dates that are specifically output by the *Wayback Machine* in its results, *see* results screen titled “Search Results for Jan 01, 1996 – Dec 30, 2004”. Thus, the date of June 12, 2000 relied upon by the Examiner as the date that the cited *Accuhire* web pages were published is inconsistent with the dates specifically output for these web pages by the relied-upon *Wayback Machine*.

Further still, even assuming that some web pages were initially uploaded to the *Wayback Machine* on June 12, 2000, as the Examiner contends, the references fail to establish that the web pages cited by the Examiner were uploaded at that time. Again, the earliest date specifically identified by the *Wayback Machine* for which archived pages are available is October 17, 2000.

In support of the Examiner’s contention that the “Screen Print of Web Page Initial Upload” establishes the date of upload of one of the cited web pages, the Examiner has highlighted a file named “benefits-share” and has handwritten a circled “1” next to it. The page following the “Screen Print of Web Page Initial Upload” provided by the Examiner appears to be a file named “C:\AccuHire Website New\benefits-create.html”, which the Examiner has circled and has handwritten a circled “1” next to. Thus, the Examiner appears

to be contending that the “C:\AccuHire Website New\benefits-create.html” file corresponds to the highlighted file on the “Screen Print of Web Page Initial Upload”. However, the file names do not match. That is, the highlighted file is named “benefits-share” and the cited page is named “benefits-create”. There is no file on the “Screen Print of Web Page Initial Upload” that is named “benefits-create”. Further, the additional *Accuhire* web pages cited by the current Office Action do not appear to be from files included in this “Screen Print of Web Page Initial Upload”, and therefore cannot be properly attributed the date of June 12, 2000. Again, the earliest date specifically identified by the *Wayback Machine*’s results themselves for which archived pages are available is October 17, 2000 (*see* Search Results for Jan 01, 1996 – Dec 30, 2004).

In view of the above, the present Office Action has failed to properly establish that the cited *Accuhire* web pages are available as prior art with respect to the claims of the present application. Therefore, as all claim rejections are based at least in part on such *Accuhire* web pages, these rejections should be withdrawn.

B. Applicant Antedates the Asserted Date of *Accuhire*

As provided in the declaration submitted herewith under 37 C.F.R. § 1.131, the inventors of the present application conceived of the claimed invention prior to June 12, 2000 coupled with due diligence from prior to June 12, 2000 to filing of the present application. Accordingly, while Applicant maintains that the *Accuhire* web pages are not properly available as 102 art (*see* above and M.P.E.P. § 2128) and further asserts that even if the *Accuhire* web pages were available as 102 art the Office Action has failed to establish that the cited web pages have a date of June 12, 2000 (*see* above, the *Wayback Machine* results themselves indicate that the date of the earliest archived *Accuhire* web pages is October 17, 2000), Applicant hereby antedates the asserted date of June 12, 2000 by submitting the accompanying declaration under 37 C.F.R. § 1.131. Therefore, as all claim rejections are based at least in part on such *Accuhire* web pages, these rejections should be withdrawn.

C. The Applied *Accuhire* Web Pages Fail to Teach All Claim Elements

As described above, Applicant respectfully submits that the *Accuhire* web pages are not proper prior art to the claims of the present application. Therefore, the claims are not

properly rejected over such *Accuhire* web pages. Further, to anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. The *Accuhire* web pages fail to teach every element of claims 1-21, 28-43, 46, 48-71, 78-79, 81, 83, and 85-101. Without conceding that the *Accuhire* web pages teach the elements of any of claims 1-21, 28-43, 46, 48-71, 78-79, 81, 83, and 85-101, Applicant identifies below exemplary ones of these claims that include limitations not taught by the *Accuhire* web pages. Again, because the *Accuhire* web pages are not prior art to these claims, Applicant maintains that the rejection is improper irrespective of the teaching of such *Accuhire* web pages.

First, it is noted that the two pages under the heading “Business Solutions” (and identified by the Examiner with a handwritten and circled “4” and “5” at the bottom thereof) included in the cited *Accuhire* web pages do not teach a system at all. Rather, these pages discuss “significant challenges facing employers”, and then concludes with an invitation to the reader to take a look at Accuhire. These pages provide no teaching regarding the Accuhire system’s operation. These, as well as the other *Accuhire* web pages cited by the current Office Action, fail to teach all elements of at least the below exemplary claims.

As one example, claim 11 recites “wherein said at least one customized application program includes an IVR application that enables access by one or more candidates via telephone.” Similarly, claim 39 recites “wherein said at least one application program includes an IVR application that enables access by one or more candidates via telephone.” Similarly, claim 60 recites “wherein said at least one qualification program includes an IVR application that enables access by one or more candidates via telephone.” The *Accuhire* web pages cited in the current Office Action make no mention of an IVR application. Thus, the *Accuhire* web pages fail to teach at least the above elements of claims 11, 39, and 60.

As another example, claim 14 recites “wherein each of said plurality of customized application programs is executable to enable interaction with candidates via a different communication platform.” Similarly, claim 42 recites “wherein each of said plurality of application programs is executable to enable interaction with candidates via a different communication platform.” The *Accuhire* web pages cited in the current Office Action provide no teaching of application programs for interacting with candidates via different

communication platforms. Thus, the *Accuhire* web pages fail to teach at least the above elements of claims 14 and 42.

Claim 16 recites “wherein said computer program receives as input from said employer indication of one or more communication platforms on which said at least one customized application program is to enable access by candidates.” The *Accuhire* web pages cited in the current Office Action provide no teaching of receiving input from an employer an indication of one or more platforms on which a customized application program is to enable access by candidates. Thus, the *Accuhire* web pages fail to teach at least this element of claim 16.

Claim 18 recites “wherein said at least one customized application program is executable to schedule future testing with a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.” Similarly, claim 68 recites “if determined by said at least one customized application program based on said desired hiring criteria that a candidate is qualified for a position of employment with the employer, said at least one customized application program executing to schedule future testing with said candidate.” The *Accuhire* web pages cited in the current Office Action provide no teaching of an application program scheduling future testing with a candidate. Thus, the *Accuhire* web pages fail to teach at least the above elements of claims 18 and 68.

Claim 21 recites “wherein said at least one customized application program interacts with a calendaring program to schedule said future personal interview at a time available for said hiring personnel.” Similarly, claim 70 recites “if determined by said at least one customized application program based on said desired hiring criteria that a candidate is qualified for a position of employment with the employer, said at least one customized application program executing to schedule a future personal interview with hiring personnel of the employer and said candidate.” Claim 71 recites “wherein said at least one customized application program interacts with a calendaring program to schedule said future personal interview at a time available for said hiring personnel.” The *Accuhire* web pages cited in the current Office Action provide no teaching of the above elements of claims 21, 70, and 71. For instance, the *Accuhire* web pages provide no teaching of an application program scheduling a future personal interview with a candidate. Indeed, the web page identified by

the Examiner with the handwritten circled “10” at the bottom thereof specifically teaches that an employer can “Call him or her and schedule an interview the same day!!”

Claim 28 recites “said at least one customized application program outputting to a candidate determined by said customized application program as not qualifying for a position of employment with the employer one or more reasons for said candidate not qualifying.” The *Accuhire* web pages cited in the current Office Action provide no teaching of application program outputting to a candidate one or more reasons for the candidate not qualifying. Thus, the *Accuhire* web pages fail to teach at least this element of claim 28.

Claim 43 recites “further including an input device communicatively coupled to said processor-based device to enable candidates to input supplemental materials to said processor-based device.” The *Accuhire* web pages cited in the current Office Action provide no teaching of an input device to enable candidates to input supplemental materials. Thus, the *Accuhire* web pages fail to teach at least this element of claim 43.

Claim 46 recites “wherein said at least one application program is executable to electronically communicate said supplemental materials to hiring personnel.” The *Accuhire* web pages cited in the current Office Action provide no teaching of an application program that communicates supplemental materials to hiring personnel. Thus, the *Accuhire* web pages fail to teach at least this element of claim 46.

IV. Rejection Under 35 U.S.C. § 103

Claims 22-27, 44, 45, 47, and 72-77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Accuhire* in view of *McGovern*, and claims 80, 82, and 84 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Accuhire*. As discussed above, the cited *Accuhire* web pages are not properly established to be prior art to the claims of the present application. Therefore, all rejections based in whole or in part on the *Accuhire* web pages are improper and should be withdrawn.

V. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Dated: March 6, 2005

Respectfully submitted,

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